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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/810,556	03/19/2001	Koichiro Tsuda	Q63566	6828

7590 10/08/2004

SUGHRUE, MION, ZINN, MACPEAK & SEAS
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037

EXAMINER	
BORISSOV, IGOR N	

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 10/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/810,556	TSUDA ET AL.	
	Examiner	Art Unit	
	Igor Borissov	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 June 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

New claims 13-18 have been added. Claims 1-18 are currently pending in the application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 6-10 and 12-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Schultz (US 6,208,988).

Schultz teaches a method and system for identifying themes associated with a search query using metadata and for organizing documents responsive to the search query in accordance with the themes, comprising:

As per claims 1, 7 and 13,

loading meta-data for each of a plurality of articles, said meta-data is described by definitions that publishers provide to define said electronic articles differently by absorbing said different definitions (column 1, lines 49-67; column 3, line 30); storing data loaded by said meta-data loading step in a database (column 1, lines 49-67);

providing search means for searching through said database (column 1, lines 49-67);

obtaining said electronic article based on link information indicated by said meta-data (column 1, lines 49-67).

As per claims 2 and 8, said method and system, wherein said meta-data is an article bibliography or an article subscriber of said electronic article and link information

indicating a place where its original article is placed electronically (column 10, lines 51-62).

As per claims 3 and 9, said method and system, further comprising:

storing subscriber's additional information in a subscription master, wherein said search means comprises access right authorization means for authorizing a subscriber's access right based on information from said subscription master (column 6, lines 22-43).

As per claims 4 and 10, said method and system, further comprising a billing means for billing a subscriber based on information from said subscription master when a search is executed (column 5, lines 43-60).

As per claims 6 and 12, said method and system, wherein said meta-data is provided by each of said publishers over said computer network or thrcugh an auxiliary memory medium (column 2, lines 57-60).

As per claim 14, loading meta-data for each of a plurality of articles, said meta-data is described by definitions that publishers providing said electronic articles defines differently by absorbing said different definitions (column 1, lines 49-67). Information as to *differently from said another publisher* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).* The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed. The method steps, disclosed in Schultz would be performed the same regardless if the information is described differently form another publisher, or not.

As per claim 15, said method and system, wherein said meta-data is described by definitions that publishers are providing, said electronic articles defines differently by absorbing said different definitions (column 1, lines 49-67). Information as to *a publisher* provides *more* meta-data definitions ... *than another publisher* is non-functional

language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).* The method steps, disclosed in Schultz would be performed the same regardless if a publisher provides more meta-data definitions than another publisher.

As per claim 16, said method and system, wherein said meta-data is described by definitions that publishers are providing, said electronic articles defines differently by absorbing said different definitions (column 1, lines 49-67). Information as to *a publisher names* a category of meta-data ...differently *than another publisher* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).* The method steps, disclosed in Schultz would be performed the same regardless if a publisher names a category of meta-data ...differently than another publisher, or not.

As per claim 17, said method and system, wherein said meta-data is described by definitions that publishers are providing, said electronic articles defines differently by absorbing said different definitions (column 1, lines 49-67). Information as to *description of meta-data ... provided by a publisher is of a higher quality than description of meta-data ... provided by another publisher* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).* The method steps, disclosed in Schultz would be performed the same regardless if the description of meta-data ... provided by a publisher is of a higher quality than description of meta-data ... provided by another publisher, or not.

As per claim 18, see same reasoning as applied to claim 16.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 5 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schultz in view of Martin et al. (US 6,272,484).

As per claims 5 and 11, Schultz teaches all the limitations of claims 5 and 11, including transmitting electronic files over the Internet (column 6, lines 15-16).

However, Schultz does not specifically teach that said files are stored in Generalized Markup Language or Extensible Mark-up Language formats.

Martin et al. teach a method and system for managing electronic documents, wherein Generalized Markup Language or Extensible Mark-up Language formats are used for managing electronic files (column 6, lines 29-33).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Schultz to include that said files are stored in Generalized Markup Language or Extensible Mark-up Language formats, because it appears that the claimed features do not distinguish the invention over similar features in the prior art, and the teachings of Schultz would perform the invention as claimed by the applicant with any known formats suitable for managing electronic files.

Response to Arguments

Applicant's arguments filed 6/22/2004 have been fully considered but they are not persuasive.

In response to applicant's argument that Schultz does not teach that *meta-data definitions are described differently for each document record*, it is noted that Schultz teaches the method for identifying themes associated with a search query using metadata and for organizing documents responsive to the search query in accordance with the themes, including loading meta-data for each of a plurality of articles, said meta-data is described by definitions that publishers provide to define said electronic articles by absorbing said different definitions, wherein the meta-data fields in the document fields are associated with composite theme scores, each of which (scores) is compared to a threshold (C. 1, L. 49-67; C. 3, L. 30), thereby indicating said inventive feature.

In response to applicant's argument that Martin does not teach that *meta-data definitions are described differently for each document record*, it is noted that Martin was not applied for this feature. Martin was applied for to show use of Generalized Markup Language or Extensible Mark-up Language formats for managing electronic files (C. 6, L. 29-33).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308- 2702.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to:

(703) 872-9306 [Official communications; including After Final communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

IB
10/01/2004

DEAN T. NGUYEN
PRIMARY EXAMINER